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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/301,811	04/28/1999	JOHN R. HURST	242/044	6113

7590

07/02/2002

ARENA PHARMACEUTICALS, INC  
6166 NANCY RIDGE DR.  
SAN DIEGO, CA 92121

EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/02/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/301,811

Applicant(s)

HURST ET AL.

Examiner

Marianne Allen

Art Unit

1631

-, The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 10-33 and 37-45 is/are pending in the application.
- 4a) Of the above claim(s) 37-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/15/02 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

Claims 37-45 remain withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

Claims 1 and 10-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claim 10 has been amended to recite "wherein a first of the database." It appears that this phrase is incomplete. Basis for such claim language is not apparent.

Claim 10 has also been amended to refer to a "row" and "to correlate rows." While the specification at page 24 refers to associating rows of databases implemented in the form of tables

in the context of relational database systems, the specification does not disclose association of databases generically with respect to rows. Note that the claims are not limited to relational databases nor databases in the form of tables.

While the response on page 5 indicates that the claims have been amended to recite that a join is performed on two database tables, this is not correct. As set forth above, claim 10 does not refer to tables. The amendments to claims 1 and 23 do not refer to tables or relational databases either. Basis for the claims as written is not apparent.

***Claim Rejections - 35 USC § 102***

Claims 1, 10-18, 20-26, and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Maslyn et al. (U.S. Patent No. 5,953,727).

Maslyn et al. discloses a computer-based system to search databases for similar nucleic acid and amino acid sequences. The user could choose the target sequence and level of similarity. All sequences meeting the selected criteria would be returned to the user. The database records are in tables with rows. Web applications are disclosed. Database sequences (with associated information) may be partitioned into multiple tables. Thus, a search of a target sequence would result in the joining of rows of multiple database tables to provide the results to the user. (See at least column 6, lines 34-42; column 7, lines 43-54; column 14; lines 41-53; column 15, lines 45-67; abstract and claims.)

With respect to claims 1, 10, and 23 the similar property is sequence or chemical structure information.

***Claim Rejections - 35 USC § 103***

Claims 10, 12, 14, and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitt (U.S. Patent No. 5,983,220) in view of Maslyn et al. (U.S. Patent No. 5,953,727).

Schmitt is applied as in the prior Office actions and Maslyn et al. is applied as above. Schmitt appears to be silent as to the database structure employed. However, it would have been routine in the art of relational databases at the time of the invention to partition the data into multiple tables with rows thus meeting the limitations of a first database, second database, etc., in order to facilitate storage and searching. Such partitioning permits the user to search selected parts of the data. Maslyn et al. discloses such partitioning with respect to biological information such as sequences.

Claims 1, 10-16, 19-20, 23-29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cramer et al. (U.S. Patent No. 6,240,374).

Cramer et al. is applied as in the prior Office actions. Cramer appears to be silent as to the database structure employed. However, it would have been routine in the art of relational databases at the time of the invention to partition the data into multiple tables with rows thus meeting the limitations of a first database, second database, etc., in order to facilitate storage and searching. Such partitioning permits the user to search selected parts of the data.

Claims 1, 10-16, 20, 23-28, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Grethe et al.

Grethe et al. is applied as in the prior Office actions. Grethe appears to be silent as to the database structure employed. However, it would have been routine in the art of relational databases at the time of the invention to partition the data into multiple tables with rows thus meeting the limitations of a first database, second database, etc., in order to facilitate storage and searching. Such partitioning permits the user to search selected parts of the data.

Claims 23-24 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Grethe et al. or Cramer et al. (U.S. Patent No. 6,204,374) in view of Schmitt (U.S. Patent No. 5,983,220).

This rejection is maintained for reasons of record and in view of the above remarks.

With respect to all of the above art rejections, applicant argues that the text does not include the word "join" and therefore cannot suggest the claimed invention. This is not agreed with. The "join" concept set forth in the claims is anticipated or suggested by the prior art even in the absence of the same terminology. Associated database tables with rows would have been well known implementations of databases at the time of the invention. Partitioning of such databases would have been well known in the art at the time of the invention.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 7:00 am - 1:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

*Marianne P. Allen*

Marianne P. Allen

Primary Examiner

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mpa

June 24, 2002